

ESTTA Tracking number: **ESTTA466151**

Filing date: **04/09/2012**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	92055230
Party	Defendant French Kiss Cosmetics, Inc.
Correspondence Address	FRENCH KISS COSMETICS INC 73008 WILLOW STREET PALM DESERT, CA 92260 UNITED STATES
Submission	Motion to Dismiss - Rule 12(b)
Filer's Name	Brian P. Kinder
Filer's e-mail	bkinder@tklglaw.com
Signature	/BPK/
Date	04/09/2012
Attachments	2012.04.09 - Motion to Dismiss.pdf ( 6 pages )(22021 bytes )

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**  
**TRADEMARK TRIAL AND APPEAL BOARD**

In the Matter of Trademark Registration No. 3384522  
For the Mark: FRENCH KISS COSMETICS  
Date Registered: February 19, 2008

GUERLAIN S.A.,

Petitioner,

v.

FRENCH KISS COSMETICS INC.,

Registrant.

Cancellation Proceeding No. 92055230

**REGISTRANT’S MOTION TO DISMISS**

Pursuant to FRCP §12(b), §56(c), and 37 CFR §2.127, Registrant French Kiss Cosmetics Inc. (“Registrant”) moves the Board to dismiss Guerlain S.A.’s (“Petitioner”) Petition to Cancel, dated February 23, 2012, because Petitioner lacks standing to bring the claims set forth in the Petition to Cancel, has no “real interest” in the proceeding, lacks standing to bring the abandonment and invalidity claims, and has not adequately stated a claim upon which relief can be granted.

**INTRODUCTION**

Petitioner alleges that the trademark registration for “FRENCH KISS COSMETICS” should be cancelled because either (a) Registrant has abandoned the mark, and/or (b) Registrant’s registration is invalid under Section 1 for lack of good faith, commercial use prior to the filing of the Statement of Use. However, the entire Petition to Cancel is a mere five paragraphs in length and contains nothing more than vague, ambiguous, and slippery wording

that never truly asserts the type of facts and allegations necessary to establish standing.

Accordingly, as set forth below, the Petition should be dismissed with prejudice.

### **STANDARD FOR MOTION TO DISMISS**

For the purpose of determining a motion to dismiss, all of Petitioner's well-pleaded allegations are accepted as true, and all alleged facts are construed in a light most favorable to Petitioner. *Stanspec Co. v. American Chain & Cable Co. Inc.*, 531 F.2d 563, 189 USPQ 420 (CCPA 1976). In order to withstand a motion to dismiss, Petitioner must plead facts that, if proved, would establish that (1) Petitioner has standing and (2) a valid ground exists for canceling the subject registration. *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 1026, 213 USPQ 185, 187 (Fed. Cir. 1982).

### **ARGUMENT**

#### **A. Petitioner Lacks Standing.**

A petitioner must show that it has standing to challenge the validity of a registered trademark. *See Lipton Industries*, 213 USPQ at 187. Standing is a threshold requirement that must be established by a petitioner in every case. *Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023, 1025 (Fed. Cir. 1999). In that regard, a petitioner must allege facts sufficient to show a "real interest" in the proceeding, and a "reasonable basis" for its belief that it would suffer some kind of damage if the mark is registered. *See* TBMP 309.03(b); *see also Ritchie v. Simpson*, 50 USPQ2d at 1025; *Lipton Industries, Inc.*, 213 USPQ at 189. To plead a "real interest," the petitioner must allege a "direct and personal stake" in the outcome of the proceeding. *Id.* The allegations in support of plaintiff's belief of damage must have a reasonable basis "in fact." *Ritchie v. Simpson*, 50 USPQ2d at 1027 (citing *Universal Oil Products v. Rexall Drug &*

*Chemical Co.*, 463 F.2d 1122, 174 USPQ 458, 459- 60 (CCPA 1972), and stating that the belief of damage alleged by plaintiff must be more than a subjective belief). The purpose of the standing requirement is to prevent litigation when there is no real controversy between the parties. *Lipton Industries, Inc.*, 213 USPQ at 189.

As the CCPA explained in *Lipton*, “a reasonable basis for a belief that one is damaged by a registration sought to be cancelled [is easily established by] asserting either a likelihood of confusion which is not wholly without merit (as in *Norac*) or, as in [*Lipton*], a rejection of an application during prosecution.” *Lipton Industries, Inc.*, 213 USPQ at 189. Moreover, the Board has explained that a Petitioner may even plead some intention to rightful use of the same or a similar mark for the same or similar goods as Registrant’s mark/goods and that the continued registration of Registrant’s mark would be in derogation of Petitioner’s right to continue to rightfully use its pleaded mark on grounds of a likelihood of confusion. *See Miller v. B&H Foods, Inc.*, 209 USPQ 357, 359-60 (TTAB 1981); *see also See Am. Vitamin Products Inc. v. Dow Brands Inc.*, 22 USPQ2d 1313, 1314 (TTAB 1992). However, unless a petitioner asserts the basis for the petition, then they are simply an intermeddler.

Here, the Petition to Cancel fails to plead Petitioner’s rightful use of a mark that is the same or similar to Registrant’s mark, a pending application, a refusal of registration, or any other such basis. Instead, Petitioner suggests that it “intends” at some unidentified time in the future to use the mark FRENCH KISS in the U.S. for perfumery. While these allegations might be sufficient to establish that Petitioner has some bona-fide intent to use the mark in the future, Petitioner still fails to allege that the continued registration of Registrant’s mark would result in a derogation of Petitioner’s rights. Instead, Petitioner suggests that Registrant’s registration for

FRENCH KISS COSMETICS “might block an application by Petitioner or diminish its goodwill.”

The foregoing is anything but axiomatic in that Petitioner entirely fails to identify: 1) the mark to which this other “an application” would be directed to (one might infer that Petitioner is referencing an application to FRENCH KISS for perfumery – but it is not clearly stated), 2) the grounds upon which Registrant’s registration “might block” such “an application” (again, one might guess that Petitioner is asserting a likelihood of confusion between the two marks – but again it is not clearly stated), or 3) how Registrant’s registration might “diminish the goodwill” (particularly since there can be no goodwill without use) – or even the mark corresponding to such goodwill (again, one might guess that it relates to the future anticipated FRENCH KISS for perfumery application – but unclear).

If Petitioner itself is not actually using its mark, does not know or cannot say when or whether such use is to commence, has not filed an intent to use application, has not been refused registration, and doesn’t even allege a basis for harm (such as a likelihood of confusion or any other basis for challenge) between some future intended unidentified mark and/or application, then the Petition to Cancel must be dismissed on the basis that it fails to adequately plead standing to bring this action. *See Lipton Industries*, 213 USPQ at 189.

### **CONCLUSION**

The Petition to Cancel should be dismissed because Petitioner lacks standing and has failed to adequately plead a claim upon which relief may be granted. Petitioner lacks standing because it does not allege that the continued registration of Registrant’s mark will cause Petitioner injury, nor does it state any facts to support a belief that it would be injured. Petitioner

lacks standing because it has failed to plead its rightful use of the same or a similar mark for the same or similar goods as Registrant's mark/goods, and has failed to plead that the continued registration of Registrant's mark would be in derogation of Petitioner's right to continue to rightfully use its pleaded mark. Accordingly, Registrant respectfully requests that the Petition to Cancel be dismissed with prejudice.

Respectfully submitted,

Dated: April 9, 2012

THE KINDER LAW GROUP, APC

A handwritten signature in dark ink, appearing to read "B. Kinder", is positioned above a horizontal line.

---

Brian P. Kinder, Esq.  
Attorneys for Registrant  
19200 Von Karman Avenue, Fourth Floor  
Irvine, CA 92612  
(949) 216-3070 (Telephone)  
(949) 216-3074 (Facsimile)  
bkinder@tklglaw.com

**CERTIFICATE OF TRANSMISSION AND SERVICE**

I certify that on April 9, 2012, the foregoing MOTION TO DISMISS is being electronically-filed with the U.S. Trademark Office Trademark Trial and Appeal Board via the ESTTA web-server, and is also being served by mailing a copy thereof via U.S. Postal Service first-class mail with postage pre-paid thereon and addressed to:

David Ehrlich, Esq.  
Fross Zelnick Lehrman & Zissu Pc  
866 United Nations Plaza  
New York NY 10017-1822



---

Brian P. Kinder  
THE KINDER LAW GROUP  
19200 Von Karman Avenue, Fourth Floor  
Irvine, CA 92612  
(949) 216-3070 (Telephone)  
(949) 216-3074 (Facsimile)  
bkinder@tklglaw.com